

Application No.: 09/888,286
Amendment dated: August 18, 2004
Reply to Final Office Action of: February 18, 2004

REMARKS

In response to the final office action dated February 18, 2004, and a subsequent advisory action dated May 13, 2004, Applicant is submitting a Request for Continued Examination ("RCE"). In the advisory action the Examiner indicated that the response submitted by Applicant on April 19, 2004, was not entered because the proposed amendments raise new issues that require further consideration and search. The Examiner also indicated that the proposed amendments would not be entered for purposes of the Appeal. Accordingly, Applicant is submitting the same proposed amendments here together with a Request for Continued Examination for the Examiner's consideration. To avoid burdening the Examiner with excessive paper, Applicant is not attaching copies of the cases cited with this response. Those cases were attached to the prior response submitted on April 19, 2004, which Applicant assumes are easily accessible to the Examiner.

The claims remaining here are 24-49, all of which stand rejected under 35 U.S.C. §103(a). Applicant treated the applied art and its distinct nature in the last Response (11/20/2003) and Applicant continues to assert the referenced distinctions. However, the crux of the current rejection is deemed to reside in the statement, "the Examiner finds no new and unobvious functional relationship between the printed matter and the substrate upon which it is placed." (DETAILED ACTION page 3). The stated authority for the required "functional relationship between the printed matter and the substrate upon which it is placed" is In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) (hereafter "*Gulack*").

The dicta of the *Gulack* case is simply not applicable to the claims of the present case. However, even more significantly, claims as in the present case were distinguished from *Gulack*

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in a later case, In re Lowry, 32 Fed 3d 1579, 1583, 32 USPQ 2d 1031, 1034 (Fed. Cir. 1994) (copy attached) (hereafter "*Lowry*").

The distinction of *Gulack* resides in the fact that the claims did not involve data to be processed by a machine. Rather the claimed subject matter involved a substrate bearing indicia useful only to the human mind. As the substrate was the only structure for which the printed indicia was relevant, the court examined the functional relationship of the indicia to the substrate. On the contrary, in the present case, the data is processed by machine. Consequently, the statements in *Gulack* regarding a functional relationship between printed matter and the substrate have no bearing here. Moreover, these statements were mere dicta. The actual holding of *Gulack* was to the effect that the PTO's "printed matter" rejection could not stand.

It is also noteworthy that any suggestion in *Gulack* regarding "printed matter" was implicitly over ruled by the 1952 Patent Act. The a printed matter rejection was based on case law anteceding the 1952 Patent Act, employing a point of novelty approach In re Sterling, 70 Fed. 2d 910, 21 USPQ 519 (CCPA 1934). The 1952 Act legislatively revised the approach through its requirement that the claim be viewed as a whole in determining obviousness. Consequently, looking for a functionally relationship between indicia and media is inappropriate. For example, such a relationship might involve some form of a penetrating ink in combination with a reactive substrate. The criteria regarding patentable subject matter is not so restricted. Rather the criteria involves a first consideration as to whether or not information on a substrate is processed by a machine, for example a computer. If that fact is established, the second consideration is whether an unobvious physical organization of information exists with its inter-relationships as claimed (*Lowry*).

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In the instant case, the initial criteria at 1583 is established. The data is processed by the telephone communication system and in accordance with a specific telephone processing format. The data clearly is not: “useful only for the human mind” per *Gulack*.

Therefore, consider the second criteria, i.e., the unobvious organization and interrelated processing of information as set forth in the claimed combinations. At the outset, the telephone number is processed by the telephone system to select a specific format. Next, unique identification data accesses certain operations within the selected format and within limitations according to a consumable key. The layer concealing the unique identification data prevents non-destructive use of the product. The additional machine readable data serves further in the combination for machine processing to establish a correlation and thereby track the product. As a final related element, “another unconcealed indicia” is specified to accommodate other aspects of the combination.

In the final analysis, the claims 24-49 clearly specified patentable subject matter within the criteria of the existing law. Specifically, the content of the printed matter called for patentably distinguishes the prior art (*Lowry*).

Respectfully, Applicant’s prior art distinctions and arguments are of record in the case. In that regard, Examiner acknowledges distinctions; however, in each instance reverts to *Gulack* and the asserted dicta of that case asserting a requirement for a functional relationship between printed matter and a substrate.

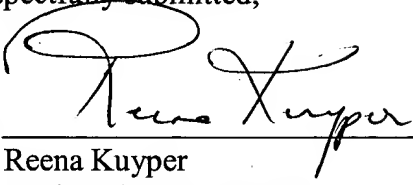
Under the circumstances, the present response distills to a plea for the consideration of the current rule of law as stated by *Lowry*. Reconsideration is respectfully requested.

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